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BP9901-US

DAE
IFW 1634

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No: 09/593,914 Confirmation No: 8319
Date Filed: June 14, 2000
Application Title: Probes, Probe Sets, Methods And Kits Pertaining To The
Detection, Identification And/Or Enumeration Of Yeast;
Particularly In Wine
Applicants: Hyldig-Nielsen et al.
Group Art Unit: 1634
Examiner: C. Myers
Application Status: Appeal Brief On File – Supplemental Brief To Be Filed
Action Type: Reply To The "Notification of Non-Compliance with 37
C.F.R. § 1.192(c)" Dated April 30, 2004

Certificate of Transmission:
37 C.F.R. § 1.8

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. 703-872-9306) on this 20th day of May, 2004.

Brian D. Gildea
Reg. No. 39,995

Attention: Bruce Campell, Director, Technology Center, 1600: Total Pages Sent: 6

Petition Under 37 C.F.R. § 1.181
Request For Review By The Office Of Petitions

Commissioner for Patents
Dear Sir or Madam:

URGENT CONSIDERATION IS REQUESTED

This petition pertains to the above captioned application. A Notice of Appeal was timely filed on August 22, 2003. An Original Appeal Brief was timely filed (with an appropriate extension) on February 18, 2004. A Supplemental Appeal Brief was filed on April 27, 2004 in response to the DENIAL of an original Petition under 37 C.F.R. § 1.144 regarding the Examiner's decision pertaining to a restriction requirement but the DENIAL of that petition is unrelated to this petition. The Examiner has now issued a

"Notice of Non-Compliance With 37 C.F.R. § 1.192(c)" (Exhibit A) in the above captioned matter having a response due date of **May 30, 2004**. The "Notice of Non-Compliance With 37 C.F.R. § 1.192(c)" appears to apply to the Original Appeal Brief filed on February 18, 2004. The Supplemental Appeal Brief filed on April 27, 2004 does not address the issues raised in the "Notice of Non-Compliance With 37 C.F.R. § 1.192(c)" as it was filed before receipt of that notice.

According to M.P.E.P. § 1206, Applicants must comply with this "Notice of Non-Compliance With 37 C.F.R. § 1.192(c)" else the appeal will be dismissed. M.P.E.P. § 1206 also states that: "if applicant disagrees with the examiner's holding of non-compliance, a petition under 37 C.F.R. 1.181 may be filed. However, 37 C.F.R. §1.181(f) states: "The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings." Because Applicants must reply to the "Notice of Non-Compliance With 37 C.F.R. § 1.192(c)" within such a short period (**May 30, 2004**) with only this petition as a remedy to the concerns discussed below and because the appeal is not stayed pending a decision on this Petition (37 C.F.R. 1.181(f)), Applicants request URGENT consideration of this Petition.

ISSUES TO RESOLVE

I. Status Of The Claims

Applicants firstly note that they will amend Section 3 the Appeal Brief (Status Of Claims) so that it clearly identifies the status of all pending claims. However, there seems to be some confusion about the status of claim 34 and this appears to be the only concern raised by the Examiner. Review of the prosecution history reveals that Applicants have never canceled or withdrawn claim 34. There also does not appear to be any affirmative statement in the record that claim 34 was withdrawn by the Examiner. Furthermore, box 4 of the Office Action Summary of the FINAL Office Action dated February 25, 2003 (from which this Appeal is taken), states that: "Claim(s) 1-8, 10-12, 16, 18-19, 21-26, 29, 32, 34, 46-49, 61-62 and 80-87 is/are pending in the application."

The "Notification of Non-Compliance With 37 C.F.R. § 1.192(c)" states that: "Claim 34 is a withdrawn claim and is not under appeal". The record does not appear to agree with the Examiner's position on this matter. Accordingly, Applicants petition

the Office Of Petitions to instruct the Examiner that claim 34 is presently pending whether or not within the subject matter under appeal.

II. The 132 Declaration

In the written comments associated with box 9 of the "Notification of Non-Compliance With 37 C.F.R. §1.192(c)" the Examiner appears to object to arguments set forth in the Appeal Brief based upon the Declaration under 37 C.F.R. § 1.132 of Dr. Henrik Stender dated August 21, 2003. By Action dated September 29, 2003, the Examiner argued that the Declaration was refused entry into the file and not considered because: "it raises new issues and is not timely filed, see MPEP 716.01."

37 C.F.R. § 1.192(a) states: "Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown". 37 C.F.R. 1.195 states: "Affidavits, declaration, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented."

As the record demonstrates, Applicants did previously submit the Declaration of Dr. Stender but it was not considered by the Examiner despite being relevant to issues long argued in the prosecution history. For this reason it is believed that the Declaration does not raise any new issues. Applicants further maintain that: 1) what Amann et al. teach is a matter of fact, raised by Appellents in the specification and in all subsequent Office Action responses; 2) the statements in the record suggest that the Examiner has consistently failed to understand the teachings of the reference and accord proper weight to those teachings in the context of the claimed subject matter and 35 U.S.C § 103(a); and 3) the Declaration supports the arguments made by Applicants during prosecution history with respect to the Amann et al. reference. Because 37 C.F.R. § 1.195 permits consideration of Declarations submitted in an Appeal with good cause shown, it is believed that this Declaration should be considered by the Board of Patent Appeals and Interferences. Appellants have provided the requisite "good cause" argument for consideration of the Declaration by the Board. Furthermore, 37 C.F.R. §1.195 appears to leave the question of whether or not to consider the Declaration to the Board and not the Examiner.

Accordingly, it is believed that the Examiner has overstepped her authority by

objecting to the content of the Appeal Brief that relates to the Declaration of Dr. Stender submitted under 37 C.F.R. § 1.132. It is believed that Appellants have the right to submit to the Board, for its consideration, all evidence supporting the patentability of claimed subject matter in the Appeal Brief else be estopped from later presenting evidence or argument (37 C.F.R. § 1.192(a)). As the Examiner has chosen to do by response in its Advisory Action dated September 29, 2003, the Board of Patent Appeals and Interferences may refuse to consider the rule 1.132 Declaration but that is the decision for the Board. However, this is not a proper basis upon which the Examiner may properly argue non-compliance with 37 C.F.R. § 1.192(c) as this issue is not specifically addressed by that procedural rule. Moreover, the Examiner's review of the Appeal Brief appears to be for the purpose of identifying deficiencies in the procedural rules and not with respect to restricting Appellants right to present all proper legal arguments. Therefore, Applicants respectfully request that the Examiner be instructed to withdraw her objection to the Appeal Brief based upon arguments directed to the Declaration of Dr. Stender submitted under 37 C.F.R. § 1.132.

Finally, Applicants would add that footnote 2 of the Appeal Brief properly informs the Board of the Examiner's refusal to consider the Declaration. Moreover, the Examiner has every opportunity to argue to the Board, in her reply to the Appeal Brief, why the Board should not consider this relevant evidence of fact.


Note

Applicants will comply with the Examiner's request to strike arguments related to the restriction requirement in the Supplemental Appeal Brief about to be filed.

Fees

The Office is hereby authorized to deduct the required fee for consideration of this petition, believed to be \$ 130.00, from Deposit Account No. 02-3240.

Respectfully submitted
On behalf of Applicants,



Brian D. Gildea; Reg. No. 39,995